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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/709,930 | 09/09/1996 | PHILIP S. GREEN | 000287-00482 | 7111 |

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EXAMINER

GARLAND, STEVEN R

ART UNIT PAPER NUMBER

2125

DATE MAILED: 06/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

08/709,930

Applicant(s)

GREEN, PHILIP S.

Examiner

Steven R Garland

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/6/02, 12/9/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 115, 118-126, 161 and 162 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 115, 123-126 and 161 is/are allowed.
- 6) ☒ Claim(s) 118-122 is/are rejected.
- 7) ☒ Claim(s) 162 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 51, 52.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 12/6/02 has been entered.

The amendment submitted 12/9/02, with certificate of mailing for 11/27/02, has been entered in part. The portions of the amendment which have not been entered are amended claims 138,118,141.

2. It is noted that original claims 138 and 141 were refused by the board in the decision of 12/22/00. At the time of appeal original claim 139 was objected to but was dependent on claim 138. Objected to claim 139 however was not rewritten in independent form prior to the decision by the board and thus claim 139 was also refused. Applicant can now not rewrite former claim 139 as claim 138, since both original claims 138 and 139 were refused by the board and also applicant can not now claim the subject matter of former claim 139. Further the change of dependency of claim 118 to make it dependent on a refused claim is not proper and therefore has not been entered. See MPEP section 1214.06.

3. In regards to the information disclosure statements filed 12/6/02. The first information disclosure statement listing various papers from the interference files has been considered, but the documents listed on it have been crossed off so that they will not listed on the face of any patent issuing from the instant application. Also the documents listed on this form are not published documents.

4. In regards to the second information disclosure statement filed on 12/6/02, the information cited on this form has been considered to the extent indicated. The information disclosure statement filed 12/6/02 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. No copies of the U.S. patent documents listed on pages 1-2 of this form were provided. The information disclosure statement filed 12/6/02 also fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of DE 9204110 and FR 2593106 documents listed on page 2 of this form, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. As to the documents from the interference files and related litigation the documents listed on the form have been considered but have been crossed off since they have no publication date and so that they will not listed on the face of any patent issuing from the instant application.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 119-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk 5,217,003 in view Heer et al. (as cited by applicant on the IDS statement filed 12/6/02 and which contains the article Endocorporeal Surgery Using Remote Manipulators by Rasor et al. on pages 483-492).

Wilk teaches a robotic surgical system with an arm, controller, and coupler. See the figures; col. 1, line 51 to col. 2, line 16; col. 2, line 33 to col. 3, line 64; and the claims.

Wilk however does not specifically state that proportional movement is accomplished, that an articable endoscopic instrument is used or that a cauterizer is used.

Heer et al. teaches a surgical robotic system with an arm, coupler, articable endoscopic surgical instrument, controller, handle, proportional movement, and cauterizer. See pages 488-492 and figures 10 and 11.

It would have been obvious to one of ordinary skill in the art to modify Wilk in view of the teaching of Heer and use proportional movement for ease in control; use an articable endoscopic instrument for more precise control and use a cauterizer to stop bleeding. This combination of features would allow greater ease in use and also reduce injury to the patient.

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7. Claim 118 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kwoh 5,078,140 in view of the article by A. M. Sabatini et al. « Force feedback based on telemicromanipulation for robot surgery of soft tissues as set forth in the final office action of 7/19/00.

Note that the amendment to claim 118 has not been entered and also note the 104 645 interference, and Papers No. 97 and 98 for example.

8. Claims 115,123-126,161 are allowed.

9. Claim 162 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R Garland whose telephone number is 703-305-9759. The examiner can normally be reached on Monday –Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239; for after final faxes 703-308-7238; and for non official faxes 703-746-7240.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3900.

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Steven R Garland
Examiner
Art Unit 2125

L. P. Picard

LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100